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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/871,649	06/04/2001	Ko-Meng Chen	MR2349-645	9781

4586 7590 06/30/2004

ROSENBERG, KLEIN & LEE
3458 ELLICOTT CENTER DRIVE-SUITE 101
ELLICOTT CITY, MD 21043

EXAMINER

TIV, BACKHEAN

ART UNIT	PAPER NUMBER
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2151

DATE MAILED: 06/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/871,649

Applicant(s)

CHEN, KO-MENG

Examiner

Backhean Tiv

Art Unit

2151

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 6/4/01.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

Detailed Action

Claims 1-3 are pending in this application.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are not of a method structure but rather a system, because steps in a method uses gerund to identify the steps.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 6,441,916 issued to Toyoda in view of US Patent 6,493,105 issued to Onuma in further view of US Patent 6,710,894 issued to Ogawa..

As per claim 1, Toyoda teaches a method for changing mail sender address of an I-FAX, comprising following steps:

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(5) the mail server has corrective response(col.3,line 56-col.4,line 7; by designed parameters, this is seen as a corrective repsonse).

(6) the I-FAX informs the e-mail address of mail receiver to the mail Server(col.4,lines 10-15).

(7) the mail server has corrective response(col.5,lines 15-41;by extracting the first page and sending the Reply message to the sender, this is seen as a corrective response).

(8) the I-FAX begins to transmit mail and a block of mail sender address in the mail is filled with e-mail address of mail sender input in step (1)(col.5,lines 42-62),

(9) the mail transmitting is finished(col.5,lines 42-62, Claim 1).

However, Toyoda does not explicitly teach

(1) the e-mail address of a mail receiver and the e-mail address of a mail sender are input to the I-FAX; the e-mail address of mail sender is manually input by a user or by selecting an address from a built-in address book.

(2) a program of the I-FAX is activated.

(3) a document for facsimile is scanned.

(4) the I-FAX informs the e-mail address of sender to a mail server through SMTP.

Onuma teaches

(2) a program of the I-FAX is activated(col.3,lines 37-43).

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1 (3) a document for facsimile is scanned(col.4,lines 25-28).

2 (4) the I-FAX informs the e-mail address of sender to a mail server

3 through SMTP(col.4,lines 63-67).

4 Therefore, it would have been obvious at the time of the invention to modify the
5 method of Toyoda to explicitly add (2) a program of the I-FAX is activated, (3) a
6 document for facsimile is scanned, (4) the I-FAX informs the e-mail address of sender to
7 a mail server through SMTP as taught by Onuma in order to provide an email
8 converting apparatus which prevents receiving errors from occurring, improve
9 transmission quality, and to handle international transmissions (col.1,lines 64-67).

10 Toyoda in view of Onuma however does not explicitly teach (1) the e-mail
11 address of a mail receiver and the e-mail address of a mail sender are input to the I-
12 FAX; the e-mail address of mail sender is manually input by a user or by selecting an
13 address from a built-in address book.

14 Ogawa teaches (1) the e-mail address of a mail receiver and the e-mail address
15 of a mail sender are input to the I-FAX; the e-mail address of mail sender is manually
16 input by a user or by selecting an address from a built-in address book(col.5, line 64-
17 col.6, line 35).

18 Therefore it would have been obvious at the time of the invention to modify the
19 method of Toyoda in view of Onuma to explicitly add (1) the e-mail address of a mail
20 receiver and the e-mail address of a mail sender are input to the I-FAX; the e-mail
21 address of mail sender is manually input by a user or by selecting an address from a

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1 built-in address as taught by Ogawa in order to identify a transmitter before opening a
2 file attached to an email(col.1,lines 64-65).

3 As per claim 2, the method for changing mail sender address of an I-FAX as in
4 claim 1, wherein if the e-mail address of mail sender is not manually input or selected in
5 step (1), a default address is automatically used and fills the block of mail sender
6 address in the e-mail(Ogawa, Fig.2A, col.5, line 64-col.6, line 35).

7 As per claim 3, the method for changing mail sender address of an I-FAX as in
8 claim 1, wherein the scanning operations in step (3) can also be performed before step
9 (8)(Onuma, col.4,lines 25-28).

10
11 **Conclusion**

12 The prior art made of record and not relied upon is considered pertinent to
13 applicant's disclosure.

14 See attached, PTO-892

15 Any inquiry concerning this communication or earlier communications from the
16 examiner should be directed to Backhean Tiv whose telephone number is (703) 305-
17 8879. The examiner can normally be reached on 9 A.M.-12 P.M. and 1 -6 P.M.
18 Monday-Friday.

19 If attempts to reach the examiner by telephone are unsuccessful, the examiner's
20 supervisor, Glenton B Burgess can be reached on (703) 305-4792. The fax phone
21 number for the organization where this application or proceeding is assigned is 703-
22 872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

BT
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6/21/04

Andrew Caldwell
Andrew Caldwell